REMARKS

Applicant appreciates the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. Reconsideration of the application in light of the following remarks is respectfully requested.

Rejections

Rejection Under 35USC §102

Claims 1-3, 15-16, 20-21, and 30-31 have been rejected under 35 USC §102(e), as being anticipated by U.S. patent 7,065,567 to Squires ("Squires"). Applicants respectfully traverse the rejection and request reconsideration based on features in the claims which are not disclosed in the cited reference.

As to a rejection under §102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CAFC) 221 U.S.P.Q. 385.* The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).* The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).* The elements must be arranged as required by the claim. *In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).*

The rejection of independent claim 20, and its dependent claim 21, is respectfully

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traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 20 recites:

> "20. (Previously presented) A workflow assignment method comprising:
> receiving a user request at a server, the request having one or more user-desired product properties;
> providing in the server a prestored stylesheet having predefined rules for processing the user request;
> loading the predefined rules and the user request into a processing circuitry of the server, the circuitry configured to process the user request; and
> without communicating with one or more workflow processing devices, executing the predefined rules on the server to create a transformed user request, <u>the transformed user request comprising additional information to automatically organize workflow among the one or more workflow processing devices in accordance with the one or more user-desired product properties to produce a user-desired product</u>." (emphasis added)

Claim 20 recites receiving a user request at a server and, without communicating with workflow processing devices, executing predefined rules on the server to create a transformed user request that comprises <u>additional</u> information to automatically organize workflow among the one or more workflow processing devices. However, any transformed user request created according to the Squires reference does <u>not</u> comprise any <u>additional</u> information beyond that which is already present in the original user request.

With regard to the transformed user request comprising additional information, the Office cites the operation of job decomposition module 64 described at col. 5, ln. 42-54, and Fig. 8 of the Squires reference (Final Office Action, p.5):

> "The job <u>decomposition</u> module 64 uses workflow information created by the workflow mapping module 46 to decide how to <u>split</u> the document processing job 62. <u>Once the document processing job 62 has been split, the sub-jobs 66, 68, 70 are sent to</u> a number of <u>cells 72, 74, 76 for further processing. The job decomposition module 64 provides a flexible way to distribute sub-jobs 66, 68, 70 to cells 72, 74, 76 in the network</u>. For example, when cell 72 receives sub-job 66, the cell 72 determines how to process sub-job 72 among the printing and/or finishing devices 77, 78, 79. The job decomposition module 64 decides which of the cells 72, 74, 76 will receive the sub-jobs 66, 68, 70 to efficiently process document processing job 62." (col. 5, ln. 42-54; emphasis added)

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Thus module 64 decomposes, or splits, a larger document processing job into a plurality of smaller sub-jobs. The Squires reference further teaches in this regard:

"The document processing job 62 is composed of a multitude of printing requests. Dependent on the size of the document processing job 62 and the overall capacity of the cell arrangements in the network, the job decomposition module 64 determines how to process the document processing job 62. In the case shown in FIG. 8, the job decomposition module 64 splits the document processing job 62 into autonomous sub-jobs 66, 68, 70." (col. 5, ln. 34-41; emphasis added)

The decomposition of the document processing job 62 into sub-jobs can be further understood with reference to Fig. 7 of the Squires reference:

"For example, the workflow 46 demonstrates a document processing job to print fifty blue envelopes with red and black lettering and to print 1000 pages of a certain document with black lettering of two kinds of letterhead A & B. The workflow mapping module splits the fifty blue-type envelopes with red and black lettering and the 1000-page document with black lettering of two kinds of letterhead A & B into sub-jobs 48, 50. Thus, creating two sub-jobs 48, 50 that are mutually independent from each other." (col. 5, ln. 2-10; emphasis added)

To whatever extent, if any, that a sub-job can arguendo be considered to be a "transformed user request" of the original user request (i.e. the document processing job), the sub-job does not contain any additional information that is not present in the original document processing job.

The novel features of the present invention are not anticipated by the Squires reference in that the essential element of a transformed user request that comprises additional information (beyond the information contained in the user request) to automatically organize workflow among the one or more workflow processing devices, arranged as required by the claims and recited in as complete detail as in the claim, is absent from the reference because the reference teaches merely decomposing or splitting up the original document processing job. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claims 30 and 31 each recite limitations similar to those of claim 20, discussed above, and were "rejected for the same reasons as claim 20" (Final Office Action, p.5).

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For similar reasons as explained heretofore with regard to claim 20, the novel features of the present invention are not anticipated by the Squires reference in that at least one essential element, arranged as required by the claims and in as complete detail as in the claims, is absent from the reference. Therefore, the rejection of independent claims 30 and 31 is improper at least for this reason and should be withdrawn.

The rejection of independent claim 1, and its dependent claims 2-3, is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 1 recites:

"1. (Previously presented) A workflow management device comprising:
a communications interface configured to receive a user request comprising one or more user-desired product properties associated with a user-desired product, the interface further configured to communicate with one or more workflow processing devices located external of the workflow management device;
a storage device configured to store predefined rules data for processing the user request; and
processing circuitry configured to process the user request using the predefined rules data to produce a transformed user request without communicating with the one or more workflow processing devices, the transformed user request including information for automatically organizing workflow among the one or more workflow processing devices in accordance with the one or more user-desired product properties to achieve the user-desired product via the one or more workflow processing devices." (emphasis added)

As the communications interface configured to receive a user request, the Office identifies the input module 24 (Fig. 3) that "receives document processing (print) jobs" (Final Office Action, p.3) "via the communication links 26" (col. 3, ln. 62-63). Input module 24 is part of server 20.

Claim 1 further recites that the communications interface is configured to communicate with one or more workflow processing devices located external of the workflow management device. The Office identifies devices 5,7 (Fig. 1), and devices 77-79 (Fig. 8) as the workflow processing devices (Final Office Action, p.3).

However, neither input module 24 specifically, nor server 20 more generally, communicate with devices 5,7 or devices 77-79. Instead, server 20 communicates only with cell 4 (Fig. 1) or cell 72 (Fig. 8). It is cells 4,72, and more particularly the product cell controller of each of the cells, that communicate with devices 5,7,77-79. In this regard, the Squires reference discloses:

"The product cell controller 16 for the cell receives a sub-job 48 from the server 20 to be further processed by the cell. ... The product cell controllers 34 and 42 send the sub-jobs 48 and 50 to devices 36, 37, 38 and 44, 45, 46 in the respective cells 32 and 40 for processing." (col. 4, ln. 11-36)

Such operation is also apparent in Fig. 10.

Thus, the Squires reference does not teach that either the input module 24, or the server 20 more generally, communicates with the workflow processing devices of the system.

The novel features of the present invention are not anticipated by the Squires reference in that the essential element of a communications interface configured to receive a user request and configured to communicate with one or more workflow processing devices located external of the workflow management device, arranged as required by the claims and recited in as complete detail as in the claim, is absent from the reference because neither input module 24 nor server 20 communicate with devices 5,7,77-79. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 15 recites limitations similar to those of claim 1, discussed above, and was "rejected for the same reasons as claim 1" (Final Office Action, p.4). For similar reasons as explained heretofore with regard to claim 1, the novel features of the present invention are not anticipated by the Squires reference in that at least one essential element, arranged as required by the claim and in as complete detail as in the claim, is absent from the reference. Therefore, the rejection of independent claim 15, and its corresponding dependent claim 16, is improper at least for this reason and should be withdrawn.

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Rejection Under 35USC §103

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has

the burden under §103 to establish a *prima facie* case of obviousness by showing some objective

teaching in the prior art or generally available knowledge of one of ordinary skill in the art that

would lead that individual to the claimed invention. *See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d*

1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143

discusses the requirements of a *prima facie* case for obviousness. That section provides as

follows:

> To establish a *prima facie* case of obviousness, three basic criteria
> must be met. First, there must be some suggestion or motivation, either in the
> references themselves or in the knowledge generally available to one of
> ordinary skill in the art, to modify the reference or to combine reference
> teachings. Second, there must be a reasonable expectation of success.
> Finally, the prior art reference (or references when combined) must teach or
> suggest all the claim limitations. The teaching or suggestion to make the
> claimed combination and reasonable expectation of success must be found in
> the prior art, and not based on applicant's disclosure.

More recently, the Supreme Court, quoting *In Re Kahn, 441 F.3d, 977, 988 (CA Fed.*

2006), has clarified that "[R]ejections on obviousness cannot be sustained by mere conclusory

statements; instead, there must be some articulated reasoning with some rational underpinning to

support the legal conclusion of obviousness" *Teleflex Inc. v. KSR Int'l Co., 82 USPQ2d 1385,*

1396 (S.Ct. 2007).

Claims 4-5, 17, 22, and 24 have been rejected under 35 USC §103 (a), as being

unpatentable over U.S. patent 7,065,567 to Squires ("Squires") in view of U.S. published patent

application 2002/0184240 by Volkoff et al. ("Volkoff"). Applicant respectfully traverses the

rejection and requests reconsideration at least based on the dependence of these claims on one of

independent claims 1, 15, and 20, whose reasons for allowability over the Squires reference have

been discussed heretofore and against which the Volkoff reference has not been cited. In

addition, the reason articulated by the Office for combining the prior art elements in the manner claimed lacks a rational underpinning that would have prompted a person of ordinary skill in the relevant field to make the modification. Accordingly, the Office impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claims 6-9, 18-19, 23, 25-26, and 32-33 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent 7,065,567 to Squires ("Squires") in view of U.S. patent 6,507,857 to Yalcinalp ("Yalcinalp"). Applicant respectfully traverses the rejection and requests reconsideration at least based on the dependence of these claims on one of independent claims 1, 15, and 20, whose reasons for allowability over the Squires reference have been discussed heretofore and against which the Yalcinalp reference has not been cited. In addition, the reason articulated by the Office for combining the prior art elements in the manner claimed lacks a rational underpinning that would have prompted a person of ordinary skill in the relevant field to make the modification. Accordingly, the Office impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

In addition, dependent claim 32 is patentably distinguishable over the cited references for further reasons. Claim 32 recites:

"32. (Previously presented) The device of claim 9, wherein <u>each stylesheet corresponds to a different subset of the product properties</u>." (emphasis added)

In rejecting claim 32, the Office points to sub-job 48 of Fig. 4 of the Squires reference, and Fig. 7. However, the term "stylesheet" refers to instructions written in an extensible stylesheet language (XSL) format. There is no disclosure in the Squires reference of stylesheets in general, or such a stylesheet in particular.

The Yalcinalp reference, with regard to different stylesheets 220, teaches merely that a

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user requests a document having an associated style sheet (Fig. 3, step 300). There is no teaching or suggestion in the Yalcinalp reference, alone or in combination with the Squires reference, that each of the associated style sheets 220 corresponds to a different subset of product properties of the user request. Such an interpretation impermissibly relies on hindsight and uses the Applicant's disclosure as a blueprint for the rejection. Therefore, the rejection of claim 32 is improper for this additional reason.

Also, dependent claim 33 is patentably distinguishable over the cited references for further reasons. Claim 33 recites:

"33. (Previously presented) The device of claim 32, wherein the transformed user request generated by a first one of the stylesheets has a different workflow than the transformed user request generated by a second one of the stylesheets." (emphasis added)

In rejecting claim 33, the Office points to sub-workflows of Fig. 4 of the Squires reference. It is not clear which elements of the Fig. 4 the Office is referring to. In the Squires reference there is no disclosure of stylesheets at all, much less stylesheets that generate transformed user requests. Furthermore, the Office points out nothing in the references that teach or suggest that the transformed user request generated by a first one of the stylesheets has a different workflow than the transformed user request generated by a second one of the stylesheets. Applicant believes that such is not taught by the Yalcinalp reference, alone or in combination with the Squires reference. Any such interpretation impermissibly relies on hindsight and uses the Applicant's disclosure as a blueprint for the rejection. Therefore, the rejection of claim 33 is improper for this additional reason.

Conclusion

Attorney for Applicant(s) has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application

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patentably distinguish thereover, either taken alone or in combination with one another.
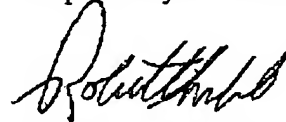
Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

HP Docket No. 100110746-1

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